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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,867	04/17/2000	James N. Freeman	134011	1611

35114 7590 07/13/2004

ALCATEL INTERNETWORKING, INC.
ALCATEL-INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

FERRIS, DERRICK W

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 07/13/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/550,867

Applicant(s)

FREEMAN, JAMES N.

Examiner

Derrick W. Ferris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-19 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7-10 and 12 is/are rejected.
- 7) ☒ Claim(s) 3,6,11 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/08/04 has been entered.

Response to Amendment

2. **Claims 1-19** as amended are still in consideration for this application.
3. Examiner **withdraws** the anticipated rejections to *Fan* and *Chiang* for Office action filed 06/08/04.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1, 2, 4, and 5** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,735,198 B1 to *Edsall et al.* ("*Edsall*").

As to **claim 1**, see figure 6 in reference to a fabric header 602. In particular, in reference to a network switch 300 in figure 3 an address is reserved and assigned in the form of a fabric header where each destination port on a particular card has a unique

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address, see e.g., column 11, lines 6-51. The network switch is interconnected to a network using the line cards. Specifically, the fabric header is used solely within the network switch 300 (i.e., back plane).

As to **claim 2**, each network switch 300 has a unique address.

As to **claim 4**, using similar reasoning in claim 1, a first address is the MAC address shown in figure 6 and a second address is the address in the fabric header. The backplane is switching fabric 350.

As to **claim 5**, each network switch 300 has a unique address where it is known in the art that the MAC address is set by the manufacturer.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 7-10 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,735,198 B1 to *Edsall et al.* ("*Edsall*") in view of U.S. Patent No. U.S. Patent No. 6,023,563 A to *Shani et al.* ("*Shani*").

In making a proper obviousness rejection under MPEP 706.02(j), the examiner will address the following four steps:

- a) *the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line numbers where appropriate;*
- b) *the difference of differences in the claim(s) over the applied cited references;*

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- c) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter; and*
- d) an explanation why one skilled in the art at the time of the invention was made would have been motivated to make the proposed modification.*

As such to **claim 7**, for step (a) *Edsall* discloses similar elements mentioned in the rejection for claims 1 and 4.

For step (b) *Edsall* may be silent or deficient to the further limitation a second address in the domain for a second manufacture or a second network switch. In particular, *Edsall* discloses only one networking switch.

Shani teaches the further recited limitation above at e.g., figure 3 and column 9, line 1-16. In particular, *Shani* discloses more than one networking switch, see e.g., network switch 3, 4, or 5. In addition, *Shani* also discloses each switch having a MAC address for a particular vendor, see e.g., column 1, lines 33-35 and column 1, lines 60-65.

For step (c), the proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Edsall* to clarify that more than one switch can be used in a network.

In order to establish a prima facie case of obviousness for step (d), three basic criteria must be met. The three criteria according to MPEP 706.02(j) are as follows:

First there must be some suggestion or modification, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As such, for step (d) examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the further limitation be a second address in the domain for a second manufacture or a second network switch. In

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particular, the motivation for modifying the reference or to combine the reference teachings would be to perform switching on more than one network segment. In particular, *Shani* cures the above-cited deficiency by providing a motivation found at e.g., figure 3 and column 9, line 1-16. Second, there would be a reasonable expectation of success since packet switching. Thus the references either in singular or in combination teach the above claim limitation(s).

As to **claim 8**, each network switch 300 has a unique address where it is known in the art that the MAC address is set by the manufacturer.

As to **claim 9**, similar reasoning is applied as claim 4 where at least one organizationally unique address is a MAC addresses and a organizationally redundant address is the address of the fabric header.

As to **claim 10**, see figure 3 where the MAC address is transmitted outside the network switch 300.

As to **claim 12**, see similar rejection to claim 7.

Allowable Subject Matter

8. **Claims 14-19** are allowed.

9. **Claims 3, 6, 11 and 13** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (703) 305-4225. The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DWF

Derrick W. Ferris
Examiner
Art Unit 2663


CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600 7/9/04